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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/869,275 06/04/97 WITTMER

C T8616.CIP5

BARNES & THORNBURG
11 SOUTH MERIDIAN STREET
INDIANAPOLIS IN 46204

HM22/0418

EXAMINER

MARSCHER, A

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

04/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/869,275

Applicant

Wittmer et al.

Examiner

Ardin Marschel

Group Art Unit
1631



☒ Responsive to communication(s) filed on Feb 15, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 13-35, 55-59, 79-82, 87-92, and 118-127 is/are pending in the application

~~Claim(s) 1-12, 36-54, 60-78, 83-86, and 93-117 have been canceled.~~ ~~Claims withdrawn from consideration~~

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13, 18-33, 35, 55-59, 79-82, 87, 89, 90, and 118-125 is/are rejected.

☒ Claim(s) 14-17, 34, 88, 91, 92, 126, and 127 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

Applicants' arguments, filed 2/15/00, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

If applicant desires priority under 35 U.S.C. § 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. It is noted that this appears as the first paragraph of the specification following the title. The status of non-provisional application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 13, 18-33, 35, 55-59, 79-82, 87, 89, 90, and 118-125 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wittmer et al. (Ref. FB).

This rejection is reiterated and maintained from the previous office action, mailed 11/9/99, and newly applied to a number of additional claim upon reconsideration. Applicants argue that the Reference FB by Wittmer et al. was published in 1998 as evidenced by the copy of the page attached to their response, filed 2/15/00. This is non-persuasive because consideration of said page revealed that this is a Copyright date designated by the symbol © therewith. This is not a publication date because copyrighting may occur at any time and does not generally coincide with the publication date. It is noted that applicants' PTO Form 1449 listed the publication date as 1997 for this reference and have not submitted a corrected version if the

publication date is incorrect. Applicants are reminded that citations on PTO Forms 1449 require a correct date of publication thereon for each citation. Also, it is noted that cataloging with the Library cataloging number occurred in 1997 as stated on that same page. Clearly the book was released for library cataloging in 1997 which again supports a 1997 date of publication.

Somewhat reworded basis for the above rejection from the office action, mailed 11/9/99. Wittmer et al.(FB) depicts a system on page 2, Figure 1, which contains capillary tubes (page 1, paragraphs 1 and 2) in a carousel which may be monitored via fluorescence. The samples are small as suggested in the ul range in the Figure 1 legend. Multiple wavelengths are monitored as noted on page 1 in lines 7-10 of the section entitled "Instrumentation". Hot and cold air(fluid) is utilized for heating and cooling as described in said Figure 1 legend. Figure 2 on page 4 of the reference describes a fluorescence signal which is updated in real time at least at each cycle of amplification. Within cycle monitoring is described starting on page 10.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice the instant invention because Wittmer et al.(Ref. FB) suggests and motivates small sample practice as required in the instant claims and describes all of the other limitations of the above

claims. The reference, taken as a whole, describes the basic instant invention directed to capillary system PCR monitoring. The rejection is also applied because the authorship of the reference is different from that of the instant application.

Claims 14-17, 34, 88, 91, 92, 126, and 127 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

April 17, 2000

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER